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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,798	11/02/2001	Camellia W. Adams	P1101R2D1	4012

9157 7590 01/25/2007
GENENTECH, INC.
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EXAMINER

O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/052,798

Applicant(s)

ADAMS ET AL.

Examiner

Eileen B. O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59,60,65,66,69-74,79,125,127-129,133,135-137 and 147-155 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59,60,65,66,69-74,79,125,127-129,133,135-137 and 147-155 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/3/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims Status

1. Claims 59, 60, 65, 66, 69-74, 79, 125, 127-129, 133, 135-137 and 147-155 are pending in the instant application. Claims 59, 65, 66, 125, 133 and 137 have been amended, claims 61, 62, 67, 68, 75-78, 80-124, 126, 130-132, 134 and 138 have been canceled and claims 147-155 have been added as requested by Applicant in the Paper filed November 3, 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 59, 60, 65, 66, 69-74, 79, 125, 127-129, 133, 135-137 remain rejected and new claims 147-155 are rejected under 35 U.S.C. 102(e) as being anticipated by Ni et al., U.S.

Published Application No. 20040136951, effective priority date March 17, 1997 (60/040,846), for the reasons set forth in the last office action.

Applicants traverse the rejection for the following reasons. The Board of Patent Appeals and Interferences (the "Board") has declared an interference, No. 105,361, between U.S. Patent No. 6,872,568 (the '568 patent) and application 10/423,448, which are drawn to antibodies to DR5/Apo-2 receptor. Applicants assert that the Board determined that the '568 patent was not

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entitled to the benefit on any of the applications to which it claimed priority for the Count in the Declaration of Interference, and therefore the Ni et al. reference is not entitled to an effective filing date prior to the filing date of the instant application for the currently pending claims, and therefore, cannot be prior art to the current application under § 102(e).

Applicants' arguments have been fully considered but are not deemed persuasive. Until the Board decides the outcome of the interference, it is not established that Ni et al. does not get priority back to the provisional application, 60/040,846. Applicants are advised that a declaration under 37 CFR 1.131 would not be sufficient to overcome the Ni et al. reference, since it is a published application claiming the same invention. Applicants could suggest an interference (see § 41.202 of the Federal Register, Vol. 69, No. 155, Thursday, August 12, 2004).

Conclusion

3. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nichol can be reached at (571) 272-0835.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner


EILEEN B. O'HARA
PRIMARY EXAMINER